

REMARKS

Claims 1-39 are pending in the application.

The Office Action objected to the drawings under 37 CFR 1.83(a) as not showing every feature of the claims.

Applicants traverse the objection to the drawings under 37 CFR 1.83(a), because of the reasons below and because corrections are made to FIGS. 1A and 1B and a new figure, FIG. 3, is added. FIGS. 1A and 1B contain no new matter and the corrections are based on the original specification, including the drawings and claims. FIG. 3 contains no new matter and is based on the original specification, including the drawings and the claims. Changes are made to the specification corresponding to new FIG. 3. These changes also contain no new matter and are based on the original specification, including the drawings and the claims.

a. The Office Action objected that “setting a trace data flag to off” (claim 1, line 3) was not shown in the drawings. Applicants traverse this objection, because FIG. 1A includes “APPLICATION IS ENTERED AND THE TRACE DATA FLAG IS SET TO OFF.” at 104.

b. The Office Action objected that “setting said trace data flag to on if said module is registered with a performance analyzer tool” (claim 1, lines 6-7) was not shown in the drawings. Applicants traverse this objection, because FIG. 1A includes “IS THE MODULE REGISTERED WITH THE PERFORMANCE ANALYZER” at 106, “IS THE TRACE DATA FLAG ON?” at 108, and “INITIALIZE THE PERFORMANCE ANALYZER AND SET THE TRACE DATA FLAG TO ON” at 110.

c. The Office Action objected that “and trace data flag is on” (claim 1, lines 9 and 12) was not shown in the drawings. Applicants traverse this objection, because FIGS. 1A and 1B include “DOES THE MODULE BEING ENTERED HAVE HOOKS?” at 112, “IS THE TRACE DATA FLAG ON?” at 113, “HAS A HOOK EVENT OCCURRED” at 118, “IS THE TRACE DATA FLAG ON?” at 119, “HAS A TERMINATE EVENT OCCURRED?” at 130, and “IS THE TRACE DATA FLAG

ON?” at 131.

d. The Office Action objected that “receiving from said ... a report” (claim 1, line 15) was not shown in the drawings. Applicants traverse this objection, because FIG. 1B includes “TERMINATE THE PERFORMANCE ANALYZER, CREATING A TRACE REPORT USING ALL GATHERED TRACE INFORMATION.” at 134.

e. The Office Action objected that “system ... processor” of claim 14 was not shown in the drawings. Applicants traverse this objection, because FIG. 3 includes computer system 300 and processor 302.

f. The Office Action objected that “storage medium” of claim 27 was not shown in the drawings. Applicants traverse this objection, because FIG. 3 includes storage 304.

The Office Action objected to the drawings under 37 CFR 1.84(p)(5) as including reference sign(s) not mentioned in the description.

Applicants traverse the objection to the drawings under 37 CFR 1.84(p)(5), by amending Applicants’ Specification to change “FIG. 1” to “FIG. 1A” and “FIG. 1B”. The formal drawings were filed on October 19, 2001 and were based on the informal drawings that were filed on August 30, 2001—the same day that the application was filed. Those formal drawings contained no new matter. In the informal drawings, FIG. 1, a flow chart of one page became two pages (1A and 1B) in the formal drawings because of its size.

The Office Action objected to the abstract of the disclosure for exceeding 150 words in length as set forth in MPEP § 608.01 (b) and for repeating information given in the title as set forth in MPEP § 608.01(b).

Applicants traverse the objection to the abstract, by amending the abstract.

The Office Action objected to claims 7-8, 20-21 and 33-34 are objected to as being informal.

For claims 7-8, 20-21, and 33-34, Applicants respectfully submit that we have already complied with 37 CFR 1.75(i), which states: “Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line

indentation.” For example, claim 7 sets forth two elements, each one a separate line and each indented with a tab.

The Office Action rejected claims 1-39 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Applicants traverse these rejections, because the original claims constitute their own description. In addition, Applicants traverse these rejections for the following reasons.

In the Office Action, the Examiner asked why and how the “trace data flag” is used. The “trace data flag” is an indicator (on/off) of whether a trace hook should be executed. This is supported, for example, by the original specification, page 2, paragraph [0004], lines 2-4. Each application execution instance has a “trace data flag”, which is initialized as “off” when the application is entered. This is supported, for example, by the original specification, page 2, paragraph [0004], lines 2-4. The “trace data flag” is set to “on”, when the performance analyzer is initialized. This is supported, for example, by the original specification, page 2, paragraph [0004], lines 5-6. A trace hook is one or more instructions in the execution path that cause the logging of trace data, as known by one of skill in the art. The “trace data flag” indicates whether a trace hook should execute and trace data be logged or whether a trace hook should be bypassed. This is supported by, for example, the original title, claims, drawings, and specification as a whole, including the summary on page 2, paragraph [0004].

a. The Office Action rejected claims 1, 14, and 27, because “setting a trace data flag to off” was not sufficiently described. Applicants traverse these rejections for at least the following reasons. One of skill in the art knows that flags are often used in software to indicate states or conditions. One of skill in the art also knows that trace hooks are one or more instructions in the execution path that cause the logging of trace data. The use of trace hooks is described in detail throughout the original specification. “Setting a trace data flag to off” is supported by, for example, “The method beings with a software application being entered and a trace data flag being set to off.” on page 2, paragraph [0004], lines 2-4 of the original specification. In addition, this is supported by

the original title, claims, drawings, and specification as a whole.

b. The Office Action rejected claims 1, 14, and 27, because “setting trace data flag to on” was not sufficiently described. Applicants traverse these rejections for at least the following reasons. One of skill in the art knows that flags are often used in software to indicate states or conditions. One of skill in the art also knows that trace hooks are one or more instructions in the execution path that cause the logging of trace data. The use of trace hooks is described in detail throughout the original specification. “Setting a trace data flag to on” is supported by, for example, “First, the trace data flag is set to on if the module is registered with a performance analyzer tool.” on page 2, paragraph [0004], lines 5-6 of the original specification. In addition, this is supported by the original title, claims, drawings, and specification as a whole.

c. The Office Action rejected claims 1, 14, and 27, because “transmitting request ... to record trace data” if “trace data flag is on” was not sufficiently described. Applicants traverse these rejections for at least the following reasons. One of skill in the art knows that flags are often used in software to indicate states or conditions. One of skill in the art also knows that trace hooks are one or more instructions in the execution path that cause the logging of trace data. The use of trace hooks is described in detail throughout the original specification. “Transmitting request ... to record trace data” if “trace data flag is on” is supported by, for example, “If the module does have trace data hooks and the trace data flag is on, then a request is transmitted to the performance analyzer tool to record trace data in response to encountering the embedded trace data hooks in the module. If the module does not have trace data hooks and the trace flag is on a request is transmitted to the performance analyzer tool to record trace data in response to entering and exiting the module” on page 2, paragraph [0004], lines 7-12 of the original specification. In addition, this is supported by the original title, claims, drawings, and specification as a whole.

Although, claims 2-13, 15-26, and 28-39 are not specifically rejected in the Office Action, Applicants respectfully submit that they are sufficiently supported by the original specification, including the claims and drawings to meet the written description

requirement for at least the same reasons.

The Office Action rejected claims 1-3, 5-6, 8-9, 11-16, 18-19, 21-22, 24-29, 31-32, 14-35 and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,678,883 to Berry et al. (“Berry”), and further in view of U.S. Patent No. 6,598,180 to Dryfoos et al. (“Dryfoos”).

Applicants traverse these rejections, because Berry and Dryfoos are directed to different problems and because Dryfoos teaches away from the proposed combination as shown below.

Berry and Dryfoos are directed to different problems than the problem addressed by the claimed invention, which is recording trace data from software compiled with trace hooks and only recording trace data in response to entry and exist of modules from software compiled without trace hooks. Berry is generally directed to a linker/loader problem, i.e., the problem of resolving symbols in machine code trace data to real addresses, especially in a Java environment. (Berry, abstract; col. 2, line 58 to col. 3, line 45; col. 10, lines 15-30). Dryfoos is generally directed to debugging selected versions in an environment with multiple versions of programs. (Dryfoos, title; abstract; col. 1, lines 30-56).

The Office Action states that Berry does not explicitly disclose the claimed “setting said trace data flag to on if said module is registered with a performance analyzer tool”. The Office Action erroneously equates the claimed “trace data flag” with a “used or referenced trace flag” in Berry that indicates that a module has been loaded but has not yet been used or referenced. (Berry, col. 25, lines 27-33). Whether the module has been loaded is information relevant to symbolic resolution and not relevant to the claimed “setting said trace data flag to on if said module is registered with a performance analyzer tool.” (Berry, col. 25, lines 27-58). In Berry, this “MTE information” indicates when modules are loaded or unloaded, which is only relevant to symbolic resolution. (Berry, col. 16, line 34 to col. 17, line 20; figure 21, elements 2110, 2150, 2210-2290).

Dryfoos teaches away from the proposed combination, because it includes both the case of debugging programs identified in a registration table 306 and the case of

debugging programs not identified in the registration table 306. (Dryfoos, col. 4, lines 34-49). Thus, Dryfoos fails to address the problem addressed by the claimed invention, which is recording trace data from software compiled with trace hooks and only recording trace data in response to entry and exist of modules from software compiled without trace hooks. Dryfoos teaches away, because it indicates even if the task field in the registration table is blank, the program is debugged regardless of which task is initiating execution. (Dryfoos, col. 5, lines 43-60).

Therefore, the Office Action proposes a combination that is inoperative by not solving the problem addressed by the claimed invention, which is recording trace data from software compiled with trace hooks and only recording trace data in response to entry and exist of modules from software compiled without trace hooks.

Independent claims 1, 14, and 27 are patentable over Berry and Dryfoos for the reasons given above and because they include “setting said trace data flag to on if said module is registered with a performance analyzer tool” and “if said module includes said trace data hooks and said trace data flag is on: transmitting a request to said performance analyzer tool to record trace data in response to encountering an embedded trace data hook in said module; and if said module does not include said trace data hooks and said trace data flag is on: transmitting a request to said performance analyzer tool to record trace data in response to entry and exit of said module.”

Dependent claims 2-13, 15-26, and 28-39 inherit the patentable subject matter of their independent base claims as well as adding additional elements. Therefore, they are also patentable over Berry and Dryfoos for at least the reasons given above.

The Office Action rejected claims 4, 17 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Berry and Dryfoos as applied to claims 1, 14 and 27 above, and further in view of U.S. Patent No. 6,728,949 to Bryan et al. (“Bryant”).

Applicant traverses claims 4, 17, and 30 for the reasons given above and because Bryant fails teach or suggest anything to remedy the inoperative combination proposed.

The Office Action rejected claims 7, 20 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Berry and Dryfoos as applied to claims 1, 14 and 27 above, and further

in view of U.S. Patent No. 5,121,501 to Baumgartner et al. ("Baumgartner").

Applicant traverses claims 4, 17, and 30 for the reasons given above and because Baumgartner fails teach or suggest anything to remedy the inoperative combination proposed.

The Office Action rejected claims 10, 23 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Berry and Dryfoos as applied to claims 1, 14 and 27 above, and further in view of Applicant Admitted Prior Art ("AAPA").

Applicant traverses claims 10, 23, and 36 at least for the reasons given above.

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested. The Examiner is cordially requested to telephone, if the Examiner believes that it would be advantageous to the disposition of this case.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment, which may be required for this amendment, to Deposit Account No. 09-0463. In the event that an extension of time is required, or may be required in addition to that requested in any petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 09-0463.

Respectfully submitted,

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